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OFFICE OF PETITIONS

In re Patent No. 6,084,190 :
Issue Date: July 4, 2000 :
Application Number: 09/006,763 : DECISION ON PETITION
Filing Date: January 14, 1998 :
Attorney Docket No. 712-017 :

This is a decision on the "RENEWED PETITION TO REVIEW DENIAL OF REQUEST FOR REFUND" filed February 27, 2012, requesting a refund of the third maintenance fee.

The petition is **dismissed**.

The patent issued on July 4, 2000. The due date for payment of the third maintenance fee without a surcharge opened on July 4, 2011, and closed on January 4, 2012. The Office received timely payment of the third maintenance in the amount of \$4,730.00 on January 3, 2012.

Patent practitioner, Kathleen A. Costigan, avers that on January 3, 2012, the third maintenance fee for the above-identified patent was paid by mistake due to a clerical error. Ms. Costigan asserts that the owner of the patent instructed a member of her firm not to pay the maintenance fee by an email date December 14, 2011. Ms. Costigan, states that Glenda Carrasquillo, a secretary at the firm, erroneously conveyed a message to her that instruction had been received to pay the third maintenance fee when, in fact, instruction had been received not to pay the third maintenance fee. Ms. Costigan maintains: "The facts show that the patent owner never intended that the third Maintenance Fee was to be paid, the patent owner did not pay the third Maintenance Fee, and that the third Maintenance Fee was paid through an inadvertent clerical error." *Petition, 02/27/11, p. 2.*

Ms. Costigan argues that a refund of the third maintenance fee is not prohibited by the provisions of 35 U.S.C. 42(d) and 37 CFR 1.26 in view of the present circumstances. Copies of the emails from the patent owner to the firm, as well as the statement of Ms. Carrasquillo accompany the petition.

The fact that the patent owner never intended for the third maintenance fee to be paid and did not pay the third maintenance fee is not persuasive. As indicated in 37 CFR 1.366(a):

The patentee may pay maintenance fees and any necessary surcharges, or any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. Authorization by the patentee need not be filed in the Patent and Trademark Office to pay maintenance fees and any necessary surcharges on behalf of the patentee.

Thus, anyone may pay the maintenance fee and any necessary surcharges on a patent. See MPEP 2512. No verification of the authority to pay maintenance fees and any necessary surcharges in a particular patent will be made by the Office. Id.

37 CFR 1.366(g) further provides that maintenance fees and surcharges relating thereto will not be refunded except in accordance with 37 CFR 1.26 and 1.28(a). "A patentee cannot obtain a refund of a maintenance fee that was due and payable on the patent." MPEP 2520.

37 CFR 1.26(a) states that:

The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

MPEP 607.02 states, in pertinent part that:

Under 35 U.S.C. 42(d) and 37 CFR 1.26, the Office may refund: (1) a fee paid by mistake (e.g., fee paid when no fee is required); or (2) any fee paid in excess of the amount of fee that is required. See *Ex parte Grady*,

59 USPQ 276, 277 (Comm'r Pat. 1943) (the statutory authorization for the refund of fees under the "by mistake" clause is applicable only to a mistake relating to the fee payment).

When an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), **the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d).**

(Emphasis added).

In this instance, the third maintenance fee maintenance fee was due and payable on the patent. The firm paid the third maintenance fee in the amount due on January 3, 2012, within the period set forth in 37 CFR 1.362. Therefore, the submission of a maintenance fee due on a patent by one other than the patent owner is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d). Accordingly, the Office concurs with the Office of Finance. The payment of the third maintenance fee in the amount of \$4,730.00 will not be refunded.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

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